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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,954	01/29/2004	Sung-hee Hwang	1793.1164	2323

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WASHINGTON, DC 20005

EXAMINER

DINH, TAN X

ART UNIT	PAPER NUMBER
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2627

MAIL DATE	DELIVERY MODE
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08/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/765,954

Applicant(s)

HWANG ET AL.

Examiner

TAN X. DINH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 22-36 is/are rejected.
- 7) ☒ Claim(s) 37 and 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

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1) The amendment filed 7/12/2007 is acknowledged.

2) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3) Claims 1-11 and 22-35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 11/589,042. Although the conflicting claims are not identical, they are not patentably distinct from each other.

The rejection of claims 1-11 and 22-35 in previously Office action is repeated herein.

4) Claims 1-11 and 22-35 are further provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-54 of copending Application No. 11/052,165, claims 1-49 of copending Application No. 11/045,485 and claims 1-63 of copending Application No. 11/018,225. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claims 1-54 of copending Application No. 11/052,165, claims 1-49 of copending Application No. 11/045,485 and claims 1-63 of copending Application No. 11/018,225 recite the features of a write-once optical disk and method for recording or reproducing information data thereof by recording/reproducing update information into a write-once optical disc and recording/reproducing location information regarding the update information, which is the same as claims 1-11 and 22-35 of instant application with a slightly different in the way of expression. However, this/these different is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6 This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7) Claims 1-11 and 22-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over SASAKI et al (7,062,626).

The rejection of claims 1-11 and 22-35 in previously Office action

is repeated herein.

8) Claims 1-11 and 22-36 are further rejected under 35 U.S.C. 103(a) as being unpatentable over GOTOH et al (6,581,167).

GOTOH et al discloses an disc with at least one record layer, as claimed in claims 1 and 6, comprising at least one update area in which updated predetermined information is recorded (Fig.1, update information area 116, 137), an access information area in which location information regarding the updated predetermined information, which is last updated and recorded in the at least one update area is recorded (Fig.1, logical volume 100b), except to specifically show that the optical disc is write-once optical disc. Examiner take Official Notice the fact that write-once optical disc (CD-WO) is known in the recording art to be equivalent to any types of optical disc (CD-RW or DVD-RAM, DVD-RW, etc.,) for storing information data. Therefore, to substitute write-once optical disc in GOTOH et al's optical disc recording system as claimed is deem obvious to someone within the level of skill in the optical recording art.

Apparatus claims 22,25 and 31 are drawn to the apparatus of using the corresponding recording medium claimed in claims 1 and 6. Therefore, apparatus claims are rejected for the same reasons of anticipation (obviousness) as used above.

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As to claims 2,3,7,8,23,24,26,27,33 and 34, GOTOH et al shows the location information is recorded when the recording operation is end and when blocks of updated areas are filed with information (Fig.1, 142).

As to claims 4,5,9,10,11,30 and 35, GOTOH et al shows the location information is recorded in access area several times (Fig.1, 110-116 and 120-122) and when the updated information reaches a predetermined number.

As to claims 28,29 and 32, GOTOH et al shows controller controls the recording/reading unit to record the predetermined information updated in the update area in recording operation units (figure 3 shows the operation of system control apparatus).

As to claim 36, GOTOH et al shows updated area includes first updated area (Fig.1, 137) and second updated area (Fig.1, 143).

9) Claims 1-11 and 22-36 are further rejected under 35 U.S.C. 103(a) as being unpatentable over SHIN (6,529,458).

SHIN discloses an disc with at least one record layer, as claimed in claims 1 and 6, comprising at least one update area in which updated predetermined information is recorded (Fig.5, update information area DMA1 and DMA2), an access information area in which location information regarding the updated predetermined information, which is last updated and recorded in the at least one

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update area is recorded (Fig.1, data area), except to specifically show that the optical disc is write-once optical disc. Examiner take Official Notice the fact that write-once optical disc (CD-WO) is known in the recording art to be equivalent to any types of optical disc (CD-RW or DVD-RAM, DVD-RW, etc.,) for storing information data. Therefore, to substitute write-once optical disc in GOTOH et al's optical disc recording system as claimed is deemed obvious to someone within the level of skill in the optical recording art.

Apparatus claims 22,25 and 31 are drawn to the apparatus of using the corresponding recording medium claimed in claims 1 and 6. Therefore, apparatus claims are rejected for the same reasons of anticipation (obviousness) as used above.

As to claims 2,3,7,8,23,24,26,27,33 and 34, SHIN shows the location information is recorded when the recording operation is end and when blocks of updated areas are filed with information (Fig.1, DMA1 and DMA2).

As to claims 4,5,9,10,11,30 and 35, SHIN shows the location information is recorded in access area several times (Fig.1, DMA1, DMA2, DMA3 and DMA4) and when the updated information reaches a predetermined number.

As to claims 28,29 and 32, SHIN shows controller controls the recording/reading unit to record the predetermined information updated in the update area in recording operation units (figure 3 shows the operation of system control apparatus).

As to claim 36, GOTOH et al shows updated area includes first updated area (Fig.1, 137) and second updated area (Fig.5, DMA1 and DMA2).

10) Claims 37 and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11) Applicant's arguments filed 7/12/2007 have been fully considered but they are not persuasive.

First, the effective date of SASAKI et al is Feb 20th 2003 and applicant's effective date is Feb 28th 2003 and that make the reference of SASAKI et al still valid.

Second, 37 CFR 131(b) stated that " The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained ". It

appears that the translation of the documents did not corresponding to the invention in this instant application. The documents simply pointing out the concept of write-once optical disc and this concept could exist on a huge numbers of patent applications. Therefore, the document are failed to establish the condition of 37 CFR 131(b).

for that reasons, the claims are still found to be rejectable as shown above.

12) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant is reminded that in amending in response to a rejection of claims (if the rejection involves with any applicable arts), the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must also show how the amendments avoid such references and objections. See 37 CFR § 1.111(c).

Form PTO-892 is attached herein.

13) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN XUAN DINH whose telephone number is (571)272-7586. The examiner can normally be reached on MONDAY to FRIDAY from 9:00AM to 5:00PM.

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The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TAN DINH
PRIMARY EXAMINER
August 16, 2007